

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BORIS G. TRAKTOVENKO
and
RICHARD J. ERICSON

Appeal No. 2004-2072
Application No. 10/036,678

ON BRIEF

Before COHEN, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13 to 19, 23, 24 and 26. Claims 1 to 4, 10 to 12, 20, 21 and 28 are allowed. Claim 25 has been objected to as depending from a non-allowed claim. Claims 5 to 9 have been withdrawn from consideration. Claims 22 and 27 have been canceled.

We REVERSE.

BACKGROUND

The appellants' invention relates to a device for securing an end of a load bearing arrangement in an elevator system (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Brendel et al. (Brendel)	4,536,921	Aug. 27, 1985
Schmidt	5,243,739	Sep. 14, 1993

Claims 13 to 16, 19 and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schmidt.

Claims 13 to 18, 24 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Brendel.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed May 4, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed February 25, 2004) and reply brief (filed June 7, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987).

Claims 13 and 26, the independent claims on appeal, read as follows:

13. A device for securing an end of an elongated load bearing member in an elevator system, comprising:

an extruded socket portion having oppositely facing engaging surfaces inside the socket portion; and

an extruded wedge portion that is at least partially received within the socket portion such that a portion of the elongated load bearing member is received between the engaging surfaces of the socket portion and the wedge portion.

26. A device for securing an end of an elongated load bearing member in an elevator system, comprising:

a socket portion;

a wedge portion that is at least partially received within the socket portion such that a portion of the elongated load bearing member is received between the socket portion and the wedge portion; and

at least one brace member that secures the wedge portion within the socket portion, the brace member including an opening through at least one side wall of the brace member and the wedge portion including an opening, the openings being situated such that a tool can be received into the openings and utilized to manipulate the wedge portion relative to the brace [member].

The anticipation rejections of claim 13

We will not sustain the rejections of claim 13 under 35 U.S.C. § 102(b).

The appellants argue (brief, pp. 10 and 13; reply brief, pp. 1-2) that the claimed extruded socket portion and the claimed extruded wedge portion are not disclosed by either Schmidt or Brendel.

The examiner asserts (answer, pp. 8-9 and 11-12) that the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, the examiner gave the term "extruded" little, if any, patentable weight. Furthermore, the examiner maintained that the term "extruded" does not distinguish over the structure of the prior art. The examiner's position is that the term "extruded" is merely a method of forming and not a structural limitation.

In our view, the term "extruded" as used in claim 13 is a structural limitation entitled to patentable weight since extruding imparts distinctive structural characteristics

to the final product. Since neither Schmidt nor Brendel disclose either an extruded socket portion or an extruded wedge portion as recited in claim 13, Schmidt and Brendel do not anticipate claim 13. Accordingly, the decision of the examiner to reject claim 13 under 35 U.S.C. § 102(b) as being anticipated by Schmidt is reversed and the decision of the examiner to reject claim 13 under 35 U.S.C. § 102(b) as being anticipated by Brendel is reversed.

The anticipation rejections of dependent claims 14 to 19, 23, 24 and 26

In view of decision above to reverse the anticipation rejections of claim 13, the decision of the examiner to reject dependent claims 14 to 16, 19 and 23 under 35 U.S.C. § 102(b) as being anticipated by Schmidt is reversed and the decision of the examiner to reject dependent claims 14 to 18 and 24 under 35 U.S.C. § 102(b) as being anticipated by Brendel is reversed.

The anticipation rejection of claim 26

We will not sustain the rejection of claim 26 under 35 U.S.C. § 102(b).

The appellants argue (brief, pp. 14-16; reply brief, p. 3) that the claimed brace member including an opening through at least one side wall of the brace member and the claimed wedge portion including an opening wherein the openings are situated such

that a tool can be received into the openings and utilized to manipulate the wedge portion relative to the brace member are not disclosed by Brendel.

The examiner asserts (answer, pp. 12-13) that:

Brendel shows the brace portion 12 having an opening (area circumscribed by element 14) and also shows the wedge portion 9 having an opening 10 (see figures 1-4). Brendel further shows the openings being situated (see figure 3) such that a tool **can be** received by them for manipulating the wedge portion 9 relative to the brace 12. Importantly, opening 10 is shown as an elongated slot having a bolt 11 situated therein. Even when, as Appellant argues, the Brendel device is "locked in position" as shown in figure 3, the openings are situated such that a tool **can be** received by them for manipulating the wedge portion 9 relative to the brace 12. That is, a tool can be used to manipulate the bolt 11 such that it slides within the opening 10 (see column 5 line 58 - column 6 line 6), allowing relative movement between the wedge 9 and the brace 12.

In the alternative, the Examiner points out that the bolt 11 may properly be considered a "tool" which can be received in the openings, thus allowing for the wedge portion 9 to be manipulated, relative to the brace 12 (see figures 1-3). This alternative understanding also anticipates the claim as currently recited.

The language of claim 26 requires that the opening of the brace member and the opening of the wedge portion be capable of being situated such that a tool can be received into the openings and utilized to manipulate the wedge portion relative to the brace member. In our view, when the Brendel device is positioned as shown in Figure 3, the openings are situated such that a tool can be inserted therein, however, there is no certainty that such a tool so positioned is capable of manipulating Brendel's wedge portion 9 relative to his brace member 12 as pointed out by the appellants in their

argument. As to the examiner's alternative position, once again there is no certainty that Brendel's bolt 11 is capable of manipulating Brendel's wedge portion 9 relative to his brace member 12 when in the position shown in Figure 3 of Brendel. Accordingly, the examiner's position is based on speculation. To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) (internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

In this case, since Brendel does not necessarily function in accordance with the claimed limitations, it does not anticipate. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986).

Since Brendel does not disclose openings capable of being situated such that a tool can be received into the openings and utilized to manipulate the wedge portion relative to the brace member as recited in claim 26, Brendel does not anticipate claim

26. Accordingly, the decision of the examiner to reject claim 26 under 35 U.S.C. § 102(b) as being anticipated by Brendel is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 13 to 16, 19 and 23 under 35 U.S.C. § 102(b) as being anticipated by Schmidt is reversed; and the decision of the examiner to reject claims 13 to 18, 24 and 26 under 35 U.S.C. § 102(b) as being anticipated by Brendel is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

)
)
)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
)
)
)
)
)

Appeal No. 2004-2072
Application No. 10/036,678

Page 9

DAVID J. GASKEY
CARLSON, GASKEY & OLDS, P.C.
SUITE 350
400 WEST MAPLE ROAD
BIRMINGHAM, MI 48009

JVN/jg